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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
USG-1035-362	

Application Number	Filed
10/035,159	January 4, 2002
First Named Inventor: YOSHIURA	
Art Unit: 3692	Examiner: MAGUIRE, Lindsay M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 37,334 (Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1,34 _____

Signature

Updeep S. Gill
Typed or printed name

703-816-4030
Requester's telephone number

August 10, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

YOSHIURA et al — Atty. Ref.: 1035-362; Confirmation No. 1757

Appl. No. 10/035,159 — TC/A.U. 3692

Filed: January 4, 2002 — Examiner: MAGUIRE, Lindsay M.

For: INFORMATION COMMUNICATION APPARATUS, SERVICE PROVIDING SYSTEM, INFORMATION COMMUNICATION METHOD, INFORMATION COMMUNICATION PROGRAM, RECORDING MEDIUM STORING THE INFORMATION COMMUNICATION PROGRAM

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August 10, 2009

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the OG Notice of July 12, 2005, Applicant hereby requests a pre-appeal brief review of this case for at least the reasons set forth herein. A Notice of Appeal is filed concurrently herewith

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-15, 17-19, 23-31, 33, 35, 37-40, 43 and 44 are pending in the application.

Claims 1-15, 17-19, 23-31, 33, 35, 37-40, 43 and 44 were rejected under 35 U.S.C. §103(a) over Salvo et al. (U.S. Patent No. 6,341,271, hereinafter "Salvo") in view of Huberman (U.S. Patent No. 6,078,906). Applicants respectfully traverse this rejection.

Each of the claims at issue in the currently pending application specifically recite:

"said information generating section presumes a time when life of the article required for maintenance of the digital complex machine will end, and generates the purchase information at a time calculated by subtracting from the presumed time a purchase time required between transmission of the purchase information by the communication section and reception of a delivery of the article, which purchase time includes an auction period, a period of business discussions between the user and the dealer, and a period required between delivery of the article by the dealer and reception of delivery of the article," and

"a server controlling section set to inform a specific wholesale shop, which has the article corresponding to the purchase information, of an instruction to provide the article to the user of the digital complex machine, in a case where

there is no dealer that has transmitted sales information indicative of a sales condition which satisfies a standard value."

The Office Action concedes that Salvo fails to teach or suggest a reverse auction or the claimed server controlling section. In order to overcome this admitted deficiency, the Office Action alleges that the claimed server controlling section is taught by Huberman, citing Col. 13, lines 37-67, which refers to the direct contact between the brokers and suppliers. According to Huberman, in the situation where an agreement is reached in a reverse auction, each supplier that participates in the reverse auction is directly informed of the agreed upon price (see, e.g., Col. 13, lines 46-49).

However, according to Huberman, in the case where no supplier bids the limit price or a lower price, the reverse auction is closed without an agreement with any supplier (see, e.g., Col. 11, lines 28-33, "...declares that there is no winning supplier (step Y) and the auction ends (step Z) *without any striking of a bargain*." (Emphasis added)). There is no disclosure or suggestion anywhere in Huberman of the specifically claimed feature of a serving controlling section that automatically orders the article from a specific wholesale shop in the event that no dealer offers a sales condition that satisfies a standard value. In fact, Huberman teaches the opposite, i.e., closing the auction *without any striking of a bargain.* The claimed server controlling section results in the claimed invention providing the exemplary advantage that "it is possible to provide a desired article to the user

of the digital complex machine without fail (see, e.g., Specification, page 63, lines 5-7).

Instead, and quite to the contrary, when there is no satisfactory bid, Huberman simply ends or closes the reverse auction without any agreement with any supplier. This is virtually the opposite of what is specifically recited in the claimed invention, which ensures supply of the desired article, even if no bidder in the auction provides an acceptable price for the article.

It is respectfully submitted that Salvo fails to overcome this fundamental deficiency of Huberman. Salvo does not even recognize a reverse auction or the consequences of the case where no dealer has satisfied a standard value. Therefore, even if, *arguendo*, the combination of Salvo and Huberman were proper, the proposed combination nevertheless fails to render the claims obvious.

Additionally, the claimed invention specifically recites an arrangement that presumes a time when the life of the article required for maintenance of a digital complex machine will end, and generates purchase information at a time calculated by subtracting from the presumed time, among other things, a purchase time required between transmission of the purchase information by the communication section and reception of a delivery of the article.

In complete contrast, Salvo specifically teaches "monitoring" inventory status (see, e.g., Col. 3, lines 41-45). As discussed in earlier responses regarding references to Blankenship and Spear (see Pre-Appeal Request for Review filed

May 16, 2008), it was noted that "monitoring" is virtually the opposite of calculating when to replenish an article based on a presumed time of life of the article. In other words, when one *monitors* inventory, there is no need to presume how long the article is going to last, the *monitoring* would ostensibly do this.

The PTO has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Moreover, the proposed combination must teach or suggest all claim limitations. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Contrary to the standards articulated above for establishing a *prima facie* case of obviousness, the outstanding Office Action makes merely conclusory statements with no rational underpinning to support the conclusion of obviousness. Specifically, in response to applicants arguments, the Office Action simply concludes the presumed life of an article is taken into account by pointing to teachings relating to "monitoring." As discussed above, "monitoring" is virtually the antithesis of presuming a time of life. Why would anyone monitoring the supply of an item ever use a presumed time of life of an item as a basis for

ordering the item? There is simply no teaching of the claimed feature of presuming a time when life of the article required for maintenance of the user device will end, and thus there can be no teaching of the specifically claimed feature of generating purchase information at a time calculated by subtracting from the presumed time a purchase time required between transmission of the purchase information and reception of delivery of the article. It is respectfully submitted that Huberman fails to overcome this fundamental deficiency of Salvo

In view of the foregoing, it is respectfully submitted that the entire application is in condition for allowance. Favorable reconsideration of the application and prompt allowance of the claims are earnestly solicited

Respectfully submitted,

NIXON & VANDERHYE P.C.

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